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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,553	04/08/2004	Wilfried Fischer	29473/11372A	8366
4743	7590	08/22/2006	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 233 S. WACKER DRIVE, SUITE 6300 SEARS TOWER CHICAGO, IL 60606			GILBERT, ANDREW M	
			ART UNIT	PAPER NUMBER
			3767	

DATE MAILED: 08/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/820,553	Applicant(s) FISCHER ET AL.	
	Examiner Andrew M. Gilbert	Art Unit 3767	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,7,11-14 and 16-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,7,11-14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/8/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgements

1. This office action is in response to the reply filed on 7/10/2006.
2. In the reply, the Applicant amended claim 1, 2, 4, 6; cancelled claims 3, 5, 8-10, and 15; and added new claims 16-27.
3. Applicant filed replacement drawings to overcome the previous objection to the drawing. However, a new objection has been issued in this office action (see below).
4. Applicant filed a terminal disclaimer to obviate the double patenting rejection; however, the terminal disclaimer has been disapproved as the assignee is not of record. Thus, the double patenting rejection stands.

Information Disclosure Statement

5. The information disclosure statement (IDS) submitted on 4/8/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "10" and "15" have both been used to designate the same element shown in Figs 3 and 4. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be

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labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

7. Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation "-", on ln 3. Appropriate correction is required.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 1, 2, 6, 7, 11, 12, 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Henley (5415629). In reference to claim 1, Henley discloses a transdermal delivery system comprising: a carrier layer (14) impermeable to a substance to be delivered and comprising one or more electrodes (14; col 7, ln 53-col 8, ln 38); a reservoir (18) containing said substance to be delivered, the reservoir being formed by a contact adhesive (15; col 7, ln 53-col 8, ln 38) and provided between the carrier layer and one or more counter electrodes (col 7, ln 53-col 8, ln 38); a removable

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film (col 7, ln 53-col 8, ln 38); a battery (col 7, ln 53-col 8, ln 38); an integrated controller microchip that is fixed to the carrier layer and programmable to a prescription; a reading and writing device (col 5, lns 4-35).

10. In reference to claim 2 (see (col 7, ln 53-col 8, ln 38)); claim 6 (see (col 7, ln 53-col 8, ln 38)); claim 11 (see (col 7, ln 53-col 8, ln 38; Fig 1-2)); claim 12 (see (col 7, ln 53-col 8, ln 38; col 5, lns 4-35)); claims 14 (see (col 7, ln 53-col 8, ln 38; Figs 1-2)).

11. Claims 1, 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Gyory et al (6083190). In reference to claim 1, Gyory et al discloses a transdermal delivery system comprising: a carrier layer (Fig 1; 12, 14; col 6, ln 44-col 7, ln 50) impermeable to a substance to be delivered and comprising one or more electrodes (12, 14); a reservoir (16, 18) containing said substance to be delivered, the reservoir being formed by a contact adhesive (28; col 7, ln 53-col 8, ln 38; Fig 1) and provided between the carrier layer and one or more counter electrodes (col 7, ln 53-col 8, ln 38; Fig 1); a removable film (col 7, ln 53-col 8, ln 38); a battery (24; col 7, ln 53-col 8, ln 38); an integrated controller microchip that is fixed to the carrier layer and programmable to a prescription; a reading and writing device (24; col 7, ln 53-col 8, ln 38).

12. In reference to claim 12 (see (24; col 7, ln 53-col 8, ln 38)); claims 13-14 (see (Fig 1; col 7, ln 53-col 8, ln 38)).

13. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Keusch et al (2002/0062102). In reference to claim 1, Keusch et al discloses a transdermal delivery system comprising: a carrier layer (Fig 1-3; [0022-0025]; 111) impermeable to a substance to be delivered and comprising one or more electrodes (112, 114); a

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reservoir (120, 122; Figs 1-3) containing said substance to be delivered, the reservoir being formed by a contact adhesive ([0022-0025]) and provided between the carrier layer and one or more counter electrodes (Fig 1-3; [0022-0025]); a removable film (Fig 1-3; [0022-0025]); a battery (2); an integrated controller microchip that is fixed to the carrier layer and programmable to a prescription; a reading and writing device (2; Fig 1-3; [0022-0025]).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 2, 4, 6, 7, 11-14, 16-27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S.

Patent No. 6757560. Although the conflicting claims are not identical, they are not patentably distinct from each other because the pending application is merely more

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broad to the patented parent application and it has been held that the broader invention is anticipated by the narrow patented parent application.

Response to Arguments

15. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Haak et al (5993435); Avrahami (6148232).

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

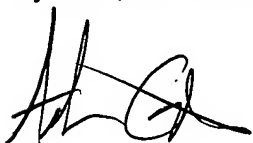
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew M. Gilbert whose telephone number is (571)

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272-7216. The examiner can normally be reached on 8:30 am to 5:00 pm Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Sirmons can be reached on (571)272-4965. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Andrew Gilbert

KEVIN C. SIRMONS
SUPERVISORY PATENT EXAMINER

